



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

nh

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/398,229	09/17/1999	JONATHAN J. HULL	74451.P100	9798

7590 02/26/2007
MICHAEL J MALLIE
BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP
12400 WILSHIRE BOULEVARD
SEVENTH FLOOR
LOS ANGELES, CA 900251026

EXAMINER

BOUTAH, ALINA A

ART UNIT	PAPER NUMBER
----------	--------------

2143

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/26/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/398,229

Applicant(s)

HULL ET AL.

Examiner

Alina N. Boutah

Art Unit

2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/27/06.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

This action is in response to Applicant's amendment filed November 27, 2006. Claims 1 and 3-45 are pending in the present application.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 14, 22 and 28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The Examiner is unable to find support for selecting and publishing a "subset" of electronic documents as claimed. Applicant is hereby requested to provide the exact support in the specification.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2143

Claims 1, 4, 14, 17, 22, 28-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolff (U.S. Patent No. 5,848,413 hereinafter, Wolff in view of Gormish (U.S. Patent No. 5,692,048 hereinafter, Gormish) in view of Epstein (U.S. Patent No. 6,584,508 hereinafter Epstein) in further view of Matsui (U.S. Patent No. 6,742,116, hereinafter Matsui).

In considering claims 1, 14, 17, 22, and 28, Wolff discloses a system for publishing electronic documents on a network (see. Fig 7) comprising:

a multifunction machine to supply multiple electronic documents (see Wolff col. 7, lines 29-30);

While Wolff discloses a multifunction machine for use in publishing documents on the Web, Wolff does not explicitly disclose wherein the multifunction machine saves the electronic documents in the absence of an explicit command by a user to save the electronic documents and in response to another user specified function associated with the electronic documents.

Nonetheless, multifunction machines that performs user specified functions as well as saving documents in the absence of an explicit command are well known as evidenced by Gormish.

In similar art Gormish discloses a fax machine that automatically saves a certain number of faxes (See Gormish col. 1, lines 46-49). It would have been obvious to a person having ordinary skill in the art to modify the system as disclosed by Wolff to include the automatic archiving feature so that documents could be stored and filed without user intervention thereby reducing time, costs, and error while providing for future search and retrieval of the documents. Therefore, the aforementioned limitations as they appear in claims 1, 14, 17, 22, and 28, above would have been obvious from the explicit teachings of

Art Unit: 2143

Gormish.

While Wolff discloses a gateway server that receives faxed images and transforms the images into documents for publication (See Wolff col. 7, lines 40-49), Wolff does not explicitly disclose wherein the gateway includes a content-based filter to transform one or more of the electronic documents to meet predetermined content based standards for publication over a network if one or more electronic documents do not meet the standards for publication.

Nonetheless, a content-based filter that translates, modifies, and transforms documents or files for publication is well known in the art as evidenced by Epstein. In similar art Epstein discloses a content-based filter that performs any necessary content-based decision-making and modifies the files by performing sanitation (e.g., excising profanity or "fizzing" data values (see Epstein col. 9, lines 7-21). It would have been obvious to a person having ordinary skill in the art to modify the gateway server disclosed by Wolff to include the content based filter as disclosed by Epstein in order to ensure that documents are reviewed prior to publications so that undesired information is not published over the network. Therefore, the aforementioned limitations as they appear in claims 1, 14, 17, 22, and 28, above would have been obvious from the explicit teachings of Epstein.

While Wolff further discloses a server coupled to the filter, the server having a memory to store the electronic documents, the server permitting access to the electronic documents using a documents identifier (See Wolff col. 7, line 40-67 through col. 8, line 3; figure 7); Wolff does not explicitly disclose authorization information to one or more recipients, the authorization information to enable the one or more recipients to access one or more of the subset of electronic documents. Nonetheless, a server that transmits authorization information to one or more

Art Unit: 2143

recipients, the authorization information to enable the one or more recipients to access restricted information is well known as evidenced by Matsui. In similar art, Matsui discloses a server that creates new passwords (authorization information) and transmits the new passwords to each user terminals to enable access to a restricted area (col. 18, lines 47-52).

It would have been obvious to a person having ordinary skill in the art to modify the system as disclosed by Wolff to include the step of the server permitting access to the electronic documents using a documents identifier as well as server transmitted authorization information in order to prevent unauthorized access to the electronic documents by only allowing invited users or those users that have received authorization information from the server. This security feature would also be advantageous in preventing the electronic documents from being retrieved by tm welcome users. Therefore, the claimed limitation would have been an obvious modification to the system disclosed by Wolff.

In considering claim 3, Wolf teaches the system defined in claim 1, wherein the multifunction machine comprises a print driver the selectively publishes one or more electronic documents on a network (See Wolff col. 7, lines 29-39).

In considering claims 4, 38-39, 41-42, and 44-45 Wolff further discloses wherein the filter provides one or more authorized users with a document identifier that comprises a Universal Resource Locator (URL) corresponding to a published electronic document (See Wolff col. 7, lines 55-60).

Art Unit: 2143

In considering claims 29-36, while the combined system of Wolff, Gormish, Epstein, and Matsui discloses a content based filter that performs sanitation (e.g. removing profanity), the system does not disclose removing confidential, pornographic, or violent material from one or more selected electronic documents. Nonetheless, Examiner takes official notice that one having ordinary skill in the art would have readily recognized the uses and advantages of additionally removing confidential, pornographic, or violent material if the one or more selected documents contain confidential, pornographic, or violent information to ensure that documents intended for publication do not include undesired information.

In considering claims 37, 40, and 43, the combined system of Wolff, Gormish, Epstein, and Matsui further discloses wherein the authorization information comprises a user name and a password sent to an authorized user (see Matsui col. 18, lines 47-57).

Claims 8-13, 15-16, 18, 23 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolff, Gormish, Epstein and Matsui, in further view of Bauer (U.S. Patent No. 6,188,673 hereinafter Bauer).

In considering claims 8, while the combined system of Wolff and Gormish discloses the system substantially as claimed, it does not disclose wherein the server maintains access logs and updates the access logs each time a published electronic document is accessed. Nonetheless, servers that maintain access logs for documents or WebPages and updates the log each time it is accessed are well known as evidenced by Bauer. In similar art Bauer discloses a system

Art Unit: 2143

associated with a World Wide Web site whose pages provide a call request capability wherein a call center receives notifications of page hits and requests from the Web server. Bauer also discloses wherein the data is stored for later use of to generate reports on historical ratios of the number of hits (See Bauer, abstract and col. 5, lines 46-48).

It would have been obvious to a person having ordinary skill in the art to modify the system as disclosed by Wolff to include the access log feature in order to maintain historical data and to use it to predict future traffic. Therefore, the aforementioned limitations as they appear in claim 8 above, would have been obvious from the explicit teachings of Wolff and Gormish.

In considering claims 9-10, Bauer further discloses a server comprising a system manager that is capable of accessing the access logs (See Bauer, col. 5, lines 37-44).

In considering claims 11-12, Bauer further discloses wherein the system manager notifies the publisher automatically, by sending an electronic mail message to the publisher in response to the electronic documents being accessed by a user (See Bauer, col. 4, lines 62-67).

In considering claim 13, while the combined system of Wolff, Gormish, and Bauer discloses the system substantially as claimed, it does not disclose the step of performing virus removal. However, the Examiner takes official notice that performing virus removal is notoriously well known in the art. A person having ordinary skill in the art would have readily recognized the desirability and advantages of modifying the filter to include the virus removal feature in order to eliminate any harmful programs from destroying the created web page.

Art Unit: 2143

Therefore, the aforementioned limitations as they appear in claim 13 above, would have been an obvious modification.

In considering claim 15, Wolff further discloses wherein sending the electronic documents comprise a multi-function machine printing the electronic documents (See Wolff col. 7, lines 29-39).

In considering claims 16 and 27, although the system taught by Wolff discloses substantial features of the claimed invention it fails to disclose wherein the server generates a security key. However Wolff does disclose wherein the server allows access to the documents by creating an identifier/locator for the documents. Thus, a person having ordinary skill in the art would have recognized the desirability generating a security key as well as an identifier so that the server would not only allow access to the documents, but also authorized access to the documents. Therefore, the claimed limitation would have been an obvious modification to the system taught by Wolff.

In considering claims 18 and 23, Wolff disclose a system further comprising the server automatically notifying a user that an electronic mail message containing a Universal Resource Locator) has been sent from the server (See Wolff col. 7, lines 55-62).

Art Unit: 2143

Claims 5-7, 19-21, and 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolff, Gormish, Epstein and Matsui, in further view of Skarbo et al. (U.S. Patent No. 6,317,777 hereinafter, Skarbo).

In considering claim 5-7, 19-21, and 24-26, although the combined system of Wolff and Bauer discloses substantial features of the claimed invention, it fails to disclose wherein the server deletes or prevents access to the documents based on certain conditions. The conditions being when an authorized user accesses the documents after the documents has been stored on the server for a predetermined amount of time, or if the documents had been accessed a predetermined number of times. Nonetheless, the auto-deletion of documents based on certain conditions is well known as evidenced by Skarbo. In similar art Skarbo discloses a system and method for web based storage and retrieval of documents wherein administrative options may be set pertaining to documents such as the auto-deletion after n days, displaying user access rates, and resources used (col. 7, lines 9-18).

Thus given the teachings of Skarbo a person having ordinary skill in the art would have recognized the desirability to modify the combined system of Wolff and Bauer to include the maintenance options, described above, so that the publisher of the documents would have control over the documents' accessibility. Therefore, the claimed limitations would have been obvious modifications to the combined system of Wolff and Bauer.

Response to Arguments

Applicant's arguments have been fully considered. However, upon further consideration, the specification does not disclose selecting and publishing a subset of electronic documents as claimed, therefore these claims are rejected for lacking enablement. The instant office action is made non-final in order that Applicant may properly respond on the record and submit any necessary amendment to the claims.

Regarding the rejection of claim 13, the attached reference (USPN 5999942 issued to Tilati) provides supports that the assertion that virus removal was well known in the art before the time of filing of the application. See Tilati col. 16, lines 44-61.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alina N. Boutah whose telephone number is 571-272-3908. The examiner can normally be reached on Monday-Friday (9:00 am - 5:00 pm).


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on 571-272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2143

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ANB

ANB


DAVID WILEY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2143